



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,512	08/13/2007	Stanley Irwin Grossman	60000005-0001	1421

26263 7590 01/27/2009
SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

NGUYEN, BAO THUY L

ART UNIT	PAPER NUMBER
----------	--------------

1641

MAIL DATE	DELIVERY MODE
-----------	---------------

01/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/583,512	Applicant(s) GROSSMAN ET AL.	
	Examiner Bao-Thuy L. Nguyen	Art Unit 1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/6/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment dated 28 October 2008 has been received.
2. Claims 12 and 19 have been canceled.
3. Claims 1-11, 13-18 and 20-25 are pending.

Priority

4. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed applications, Application No. PCT/GB2004/005261, GB 0405646.1 and GB 0329503.7, fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Application number PCT/GB04/005261 which is a continuation of GB 0405646.1 and GB 0329503.7 at page 3, lines 15-17, states: "*Thus according to the present invention there is provided a test kit for detecting the presence of one or more drugs in a beverage comprising a*

Art Unit: 1641

support having a plurality of detector strips attached thereto. The strips are preferably releasably attached thereto.”

Whereas the instant application in the same location states: “*Thus according to the present invention there is provided a test kit for detecting the presence of one or more drugs in a beverage comprising a support having a plurality of detector strips attached thereto. The strips are **may be** releasably attached thereto.*” [Emphasis added].

Therefore, the instant application does not have adequate support in the parent priority documents. Thus, priority is denied and the instant application is given the effective filing date of 16 June 2006.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-11, 13-18 and 20-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 1 recites a kit comprising a support having a plurality of drug detector strips **permanently** attached thereto. This kit is not supported by the specification as originally filed.

Art Unit: 1641

The specification at paragraphs [0015], [0037] – [0039] discloses a test kit where the support has strips that are releasably attached thereto and that the releasable strips are attached either by adhesive or connected by a frangible flange. No where in the specification is there a disclosure that the strips are *permanently* attached.

Amended claim 1 also makes claims 17, 18 and 20 lack support in the specification as originally filed since the specification does not have adequate support for a support sized such that when it is folded into two parts a first part is laid over the strips which are attached to the second part and further comprises a cover and a third part which partially folds over the first part when it is in a closed position.

The specification at paragraph [0041] recites a kit including a cover for the support to protect the detection strips when not in use. The cover is integral with the support and is a part of the support sized such that it maybe folded into two parts such that when "closed" a first part may be laid over the strips which are attached to the second part. No where in the specification is there a description of a kit where there is an additional cover on the support.

Corrections to remove the new matter is required.

Response to Arguments

7. Applicant's arguments filed 28 October 2008 have been fully considered but they are not persuasive.

Applicant argues that support for “permanently attached” is found in the specification at page 3, lines 24 -26 in the recitation of the word “may” because this is apparent that the strips may also not be releasably attached, i.e. they are permanently attached.

Art Unit: 1641

This is not persuasive. The specification teaches "*The strips are may be releasably attached thereto.*" No other definition or recitation of "permanently attached" is found. First, this sentence is grammatically incorrect and is thus confusing. Second, the parent applications in the same location recite that "*The strips are preferably releasably attached thereto.*", therefore, it cannot be conclusively determined from this recitation that the strips "permanently attached".

Applicant's arguments with respect to the 103 rejection have been considered and this rejection is withdrawn in view of the amendment to the claims. Craig and Bogema do not teach a kit where the test strips are permanently attached to a support. However, it is noted that these amendments raise the issue of new matter. When the new matter is removed, these rejections may be reinstated.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 1641

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bao-Thuy L. Nguyen whose telephone number is (571) 272-0824. The examiner can normally be reached on Monday -- Thursday from 9:00 a.m. - 3:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on (571) 272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Bao-Thuy L. Nguyen/
Primary Examiner, Art Unit 1641
January 22, 2009